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10/748,118	12/30/2003	Michael D. O'Shea	KCX-732 (19571)	1747
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HENRY, RODNEY M				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/748,118

Applicant(s)

O'SHEA ET AL.

Examiner

RODNEY M. HENRY

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) 8, 13-21, 23, 25, 34 and 37-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-12, 22, 24, 26-33 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a non-final office action on the merits. Examiner acknowledges communications dated December 17th, 2008. Claim 1 has been amended and claims 8, 13-21, 23, 25, 34, 37-50, 51-57, and 58-65 are canceled.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 17, 2008 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Litwin (US 6,374,228).**

As per Claim 1:

Litwin discloses an electronic rebate system configured for processing a manufacturer's rebate that is provided to a purchase of a product, said system

comprising:

at least one electronic tag device associated with products wherein each distinct product is associated with at least one electronic tag, and

wherein said electronic tag stores product-identification-information;

at least one electronic reading device configured to retrieve information from said electronic tag ;

a first computer in communication with said electronic reading device to retrieve said product-identification-information stored in an electronic tag associated with a product being purchased by a customer at a point of sale and for which a manufacturer's rebate applies as a result of purchase of the product;

said first computer further configured to use said product-identification-information to acquire rebate-claim-information so that the customer may receive the manufacturer's rebate;

said first computer further configured to communicate with a second computer and to transfer to said second computer said rebate-claim-information and wherein said transfer occurs substantially contemporaneous with the purchase; and

wherein said second computer is configured to process and validate a rebate claim with said rebate-claim-information, and transfer rebate-claim-status information to said first computer, said first computer configured to communicate said rebate-claim-status information to the customer (see col 7, lines 33-44, col 5, lines 59-67, and FIGS 2, 5).

As per Claim 27:

Litwin discloses a method for electronically making a claim for a manufacturer's rebate that is provided by a manufacturer upon purchase of a product, said method comprising:

- providing at least one electronic reading device configured to retrieve product-information stored in an electronic tag associated with a purchased product;

- configuring a first computer to communicate with said electronic reading device to retrieve at least part of said product-information stored in at least one electronic tag associated with a product being purchased by a customer at a point of sale thereby acquiring product-identification-information;

- configuring said first computer to acquire rebate-claim-information for making a claim for the manufacturer's rebate for purchase of the product using at least part of said product-identification-information;

- configuring said first computer to initiate a data transfer of said rebate-claim-information to a second computer; and

- configuring said second computer to process and validate the rebate claim with said rebate-claim-information, and transfer rebate-claim-status information to said first computer, said first computer further configured to communicate said rebate-claim-status information to the customer (see col 7, lines 33-44, col 5, lines 59-67, and FIGS. 2, 5).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 2-7, 9-12, 22, 28-31, 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Litwin (US 6,374,228), in view of Nguyen (US 2003/0220839).**

As per claims 2, 28 Litwin does not explicitly disclose the electronic tag device is an RFID smart tag.

However Nguyen discloses the electronic tag device is an RFID smart tag (see paragraph [0036] and FIG. 2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add electronic tag device being RFID smart tags to the system of Litwin in order to promote wireless transmissions.

As per claims 3, 29 Litwin does not explicitly disclose the electronic reading device is an RFID STR device.

However Nguyen discloses the electronic tag device is an RFID STR device (see paragraph [0036] and FIG. 2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add electronic tag device being RFID STR device to the system of Litwin in order to promote wireless transmissions.

As per claim 4, Litwin discloses a customer interface configured with said first computer to receive and communicate said rebate-claim-status information to the customer (see FIGS. 2, 5).

As per claim 5, Litwin discloses rebate-claim-status Information is one of real-time information and near real-time information (see col 5, lines 59-67).

As per claim 6, Litwin discloses product-identification-information comprises at least one member from the group consisting of: (a) product model number; (b) product serial number; (c) rebate promotion code; (d) product name; (e) identification code; (f) proof-of-purchase code; and (g) an electronic address (see Column 4, lines 16-27).

As per claims 7, 33 Litwin discloses rebate-claim-information comprises at least one member from the group consisting of: (a) customer name; (b) customer's financial institution tracking number; (c) customer's account number at customer's financial institution; (d) customer's mailing address; (e) customer's e-mail address; (f) customer's phone number; (g) customer's credit card number; (h) customer's debit card number; (i) a pin code; (j) an authorization code; (k) customer's electronic signature; (l) product model number; (m) product serial number; (n) rebate promotion code; (o) product name; (p) an electronic address; (q) proof-of-purchase code; (r) date of purchase; (s) time of purchase; (t) product identification code; (u) product information; (v) retailer name; (w) retailer location; (x) retailer identification code; and (y) transaction code. (see Column 7, lines 1-6).

As per claim 9, Litwin discloses

a first computer is further configured to generate at least one of (a) rebate status documentation comprising at least part of said rebate status information wherein said rebate status documentation is given to the customer at the point of sale and (b) a receipt comprising at least part of said rebate status information wherein said receipt is given to the customer at the point of sale (see paragraph [0033]).

As per claims 10, 35 Litwin discloses

rebate status information comprises at least one member from the group consisting of: (a) rebate claim accepted notice; (b) rebate claim denied notice; (c) rebate claim denied code; (d) rebate claim reference code; (e) EFT transaction code; (g) e-mail notice; and (h) rebate check number (see paragraph [0013]).

As per claims 11, 30 Litwin discloses that a first computer is a retailer central computer (Column 6, lines 20-31 discloses a kiosk in a retail environment, where client computer 406 is a central computer).

As per claims 12, 31 Litwin discloses

said second computer is one of (a) a manufacturer central computer and (b) a rebate processing center central computer (see col 7, lines 33-44, and FIG. 2).

As per claim 22, Litwin does not explicitly disclose

a second remote computer is a portable customer computer in communication with at least one of said first computer and said first remote computer via a wireless communication connection.

However Nguyen discloses a second remote computer is a portable customer computer in communication with at least one of said first computer and said first remote computer via a wireless communication connection (see paragraph [0036] and FIG. 2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a second remote computer is a portable customer computer in communication with at least one of said first computer and said first remote computer via a wireless communication connection to the system of Litwin in order to promote wireless transactions.

6. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Litwin (US 6,374,228), in view of McCarthy (US 5,202,826).

As per claim 24, Litwin does not explicitly disclose that a first computer is further configured to initiate an electronic fund transfer from a first bank account into a second bank account in the amount of the rebate.

However McCarthy discloses an electronic consumer rebate having a first computer configured to initiate an electronic fund transfer from a first bank account into a second bank account in the amount of the rebate (see Column 2, lines 1-30).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a first computer is further configured to initiate an electronic fund transfer from a first bank account into a second bank account in the amount of the rebate to the system of Litwin in order to allow customers to have their cash incentives deposit to their bank accounts.

7. Claims 26, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Litwin (US 6,374,228), in view of Scroggie et al. (US 6,185,541).

As per claims 26, Litwin does not explicitly disclose said first or second computer is configured to transmit an electronic mail message to a predefined electronic mail address wherein said electronic mail message contains at least part of said rebate-claim-status information.

However Scroggie et al. discloses said first or second computer is configured to transmit an electronic mail message to a predefined electronic mail address wherein said electronic mail message contains at least part of said rebate-claim-status information (See Abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add said first or second computer is configured to transmit an electronic mail message to a predefined electronic mail address wherein said electronic mail message contains at least part of said rebate-claim-status information to the system of Litwin in order to promote communication with customers electronically.

As per claims 36, Litwin discloses the elements of the claimed invention, but fails to explicitly disclose that a first computer is further configured to generate at least one of (a) rebate status documentation comprising at least part of said rebate status information wherein said rebate status documentation is given to the customer at the point of sale and (b) a receipt comprising at least part of

said rebate status information wherein said receipt is given to the customer at the point of sale.

However Scroggie et al. discloses a first computer is further configured to generate at least one of (a) rebate status documentation comprising at least part of said rebate status information wherein said rebate status documentation is given to the customer at the point of sale and (b) a receipt comprising at least part of said rebate status information wherein said receipt is given to the customer at the point of sale (See Abstract, FIGS. 11 and 12).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a receipt comprising at least part of said rebate status information wherein said receipt is given to the customer at the point of sale to the system of Litwin in order to provide customers with a record of the rebate.

8. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Litwin (US 6,374,228), in view of Lane al. (US 7,221,258).

As per claim 32, Litwin discloses product-identification-information comprises at least one member from the group consisting of: (a) product model number; (b) product serial number; (c) rebate promotion code; (d) product name; (e) identification code; (f) proof-of-purchase code; and (g) an electronic address; and (f) a URL link.

However Scroggie et al. discloses product-identification-information comprises at least one member from the group consisting of: (a) product model number; (b) product serial number; (c) rebate promotion code; (d) product name; (e) identification

code; (f) proof-of-purchase code; and (g) an electronic address; and (f) a URL link (see col 3, lines 50-60).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add identification code to the system of Litwin in order to promote ease of management of the product that are part of the rebate marketing campaign.

Response to Arguments

9. The applicant's arguments are moot in light of the new grounds of rejection above.

Conclusion

10. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney M. Henry whose telephone number is 571-270-

5102. The examiner can normally be reached on Tuesday through Friday from 7:30am to 7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached 570-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-272-6102.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RMH

/Arthur Duran/

Primary Examiner, Art Unit 3622